

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

At the outset, Applicant note with appreciation the courtesy of a personal interview extended by Examiner Joseph Phan to Applicant's representative, Chien Yuan. The personal interview was conducted on May 18, 2004.

Claims 19-39 are currently pending. Claims 19-36 are amended, and new claims 37-39 are added, by the present amendment. Claims 19-36 are also renumbered by the present amendment to be consistent with the numbering of the amended claims of the corresponding PCT application. These claims were accidentally misnumbered in the Preliminary Amendment filed April 25, 2001. Applicant respectfully submits that support for amended claims 19-36 and for new claims 37-39 is self-evident from the originally-filed disclosure, including the original claims and figures. No new subject matter is introduced by the foregoing amendment to the claims.

In the Office Action, claim 28 was rejected under 35 U.S.C. §112, second paragraph, as indefinite. Claims 19-36 were rejected under 35 U.S.C. §102(e) as anticipated by Carleton et al. (U.S. Patent No. 6,069,940; hereinafter "Carleton").

The foregoing amendment amends portions of the specification to address formalities. Specifically, specification headings (e.g., "BACKGROUND OF THE INVENTION") are added and a typographical error is addressed (i.e., "210" replaced with "207" on page 8, line 20). Thus, no new subject matter is introduced by the foregoing amendment to the specification.

Figures 1 and 2 are amended solely to include descriptive labels for the illustrated elements. Thus, no new subject matter is introduced by the foregoing amendment to the drawings.

In response to the rejection of claim 28 under 35 U.S.C. §112, second paragraph, Applicant submits that amended claim 28 particularly points out and distinctly claims subject matter that Applicant regards as being aspects of the present invention. Specifically, amended claim 28 clearly distinguishes, for example, a subscriber that originates a spoken message from the subscriber or subscribers to whom the spoken message is addressed. For example, amended claim 28 recites:

...receiving in the message exchange a spoken message from one of the subscribers in the public switched telephone network via the public switched telephone network, wherein the one of the subscribers is a transmitting subscriber...<sup>1</sup>

...designating to the message exchange at least one of the other subscribers as an addressee by means of spoken language....<sup>2</sup>

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 28 under 35 U.S.C. §112, second paragraph.

Regarding the rejection of claims 19-36 under 35 U.S.C. §102(e), Applicant respectfully submits that Carleton fails to anticipate these claims. During the personal interview, Examiner Phan indicated that the foregoing claim changes appear to overcome Carleton, but that further review and additional prior art searching would be required before a final determination of allowability could be made.

Regarding Carleton, Applicant respectfully submits that this reference fails to teach each and every feature of independent claims 19, 28, and 36. For example, claim 19 recites:

...an address module configured to store a plurality of lists with subscriber identifications, each list being assigned to at least one of the subscribers, wherein at least two of the lists include a common group identification...

a transmission module configured to transmit the stored message by means of an automatic call to the addressee, and to inquiry if a reply is to be sent from the addressee to the transmitting subscriber; and

a reply module configured to receive and to store the reply from the addressee.

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<sup>1</sup> See, e.g., Applicant's specification at paragraph beginning on page 4, line 23.

<sup>2</sup> See, e.g., *id.* at paragraph beginning at page 6, line 3.

Each of independent claims 28 and 36 also recites, inter alia, features similar those of claim 19 quoted above. Carleton, in contrast, is directed to a message system that provides for adding subject lines to voice mail messages, and does not teach or suggest the address module, the transmission module, and the reply module recited in claim 19. As such, Carleton fails to anticipate claim 19. Further, Carleton fails to anticipate claims 28 and 36, which recite features similar to those of claim 19. In addition, there is no suggestion in the prior art to modify the teachings of Carleton to arrive at the features of the present claims, and therefore, it is submitted that the prior art also fails to render obvious the present invention.

Therefore, Applicant respectfully submits that claims 19, 28, and 36 are patentable over Carleton, and requests reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. §102(e). Claims 20-27 and 37, 29-35 and 38, and 39 depend from claims 19, 28, and 36, respectively, and are also patentable for at least the reasons discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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